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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,292	12/31/2003	Ching-Chin Lin	BHT-3215-63	8406

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EXAMINER

CHAMBERS, MICHAEL S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/748,292	LIN, CHING-CHIN	
	Examiner	Art Unit	
	Mike Chambers	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claim 1 is objected to because of the following informalities:

In line 2: "the upper surface" should be – an upper surface –.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by
Murphy et al (6612938). Murphy et al discloses

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an upper surface having an ankle (hosel) formed at a first side of the upper surface, a toe formed at a second side of the upper surface opposed to the first side, a rear wall formed between the ankle and the toe, and a recess (40) transversally defined at the rear wall; and a sole having a rear side connected with the rear wall and longer than the rear wall, and a strike surface formed from the sole and extending upwards to connect with a front side of the upper surface (fig 1). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claim 3 : Murphy et al discloses a toe has a substantially upright and slightly curved outer periphery. (fig 1).

Also,

Claims 1 -3 are rejected under 35 U.S.C. 102(b) as being anticipated by Solheim (4512577). Solheim discloses

an upper surface having an ankle (hosel) formed at a first side of the upper surface, a toe formed at a second side of the upper surface opposed to the first side, a rear wall formed between the ankle and the toe, and a recess (fig 4- un-numbered recess) transversally defined at the rear wall; and a sole having a rear side connected with the rear wall and longer than the rear wall, and a strike surface formed from the sole and extending upwards to connect with a front side of the upper surface (fig 4,5). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claim 2 : Solheim discloses a sole having a greater area than the upper surface (fig 5).

As to claim 3 : Solheim discloses a toe has a substantially upright and slightly curved outer periphery. (fig 3).

Also,

Claims 1 -3 are rejected under 35 U.S.C. 102(b) as being anticipated by Jimenez et al (5827130). Jimenez et al discloses

an upper surface having an ankle (hose) formed at a first side of the upper surface, a toe formed at a second side of the upper surface opposed to the first side, a rear wall formed between the ankle and the toe, and a recess (fig 14- un-numbered recess) transversally defined at the rear wall; and a sole having a rear side connected with the rear wall and longer than the rear wall, and a strike surface formed from the sole and extending upwards to connect with a front side of the upper surface (fig 14). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claim 2 : Jimenez et al discloses a sole having a greater area than the upper surface (fig 14- the lower area has a greater area than the top area).

As to claim 3 : Jimenez et al discloses a toe has a substantially upright and slightly curved outer periphery. (fig 17).

Also,

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen (5888148). Allen discloses

an upper surface having an ankle (hose) formed at a first side of the upper surface, a toe formed at a second side of the upper surface opposed to the first side, a rear wall formed between the ankle and the toe, and a recess (fig 22- un-numbered recess) transversally defined at the rear wall; and a sole having a rear side connected with the rear wall and longer than the rear wall, and a strike surface formed from the sole and extending upwards to connect with a front side of the upper surface (fig 22). In as much structure set forth by the applicant in the claims, the device is capable of use in the intended manner if so desired (See MPEP 2112).

As to claim 3 : Allen discloses a toe has a substantially upright and slightly curved outer periphery. (fig 22,23).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6612938*5888148*4512577*5827130

Michael Chambers
Examiner
Art Unit 3711

March 14, 2005


GREGORY XIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700